

REMARKS/ARGUMENTS

Claims 1, 3-4, 7-8, 11-18, and 20-26 are pending. The Office Action objects to the numbering of the claims. Claim 22 is rejected under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the written description requirement. Claim 22 is rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. Claims 1, 3, 4, 7, 8, 11-18, and 20-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,134,719 to Mankovitz ("Mankovitz") and U.S. Pat. Pub. No. 2004/0198279 to Anttila et al. ("Anttila") in view of U.S. Pat. No. 6,697,631 to Okamoto et al. ("Okamoto").

Applicants have made clarifying amendments to several of the claims. These amendments are fully supported by the originally filed specification. Claims 8 and 26 (formerly incorrectly numbered 25 as pointed out by the objection) have been cancelled. New Claims 27-28 have been added and are fully supported by the originally filed specification. In light of the subsequent remarks, Applicants respectively submit that the claims are in condition for allowance.

The Objection to the Claim Numbering is Overcome

Applicant appreciates the Examiner pointing out the claim numbering error. As a result of this response, the second claim numbered Claim 24 has been renumbered Claim 25. The former Claim 25 has been renumbered Claim 26 and has been cancelled. The new claims added in this response have accordingly been numbered Claims 27 and 28. Applicant therefore respectfully submits that the objection is overcome.

The Rejection of Claim 22 under § 112 is Overcome

Claim 22 is rejected for allegedly failing to comply with the written description requirement. In this regard, the Office Action alleges that there is no support in the specification for a "computer program product" or for a "memory having computer-readable program instructions stored therein." Applicant respectfully traverses the rejection and submits that the Examiner has misapplied § 112, first paragraph.

First, Applicant respectfully submits that the Examiner has failed to even meet the initial burden imposed on the Examiner to present “by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” *See*, MPEP §§ 2163 (II)(A), 2163.04; *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976).

In this regard, “[i]n rejecting a claim, the examiner must set forth express findings of fact which support the lack of written description conclusion.” The findings should “[e]stablish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.” *See*, MPEP § 2163.04 (I).

At most, however, the Examiner has only alleged that the specification of the present application does not include a literal citation of the phrases “computer program product” and “memory having computer readable program instruction” and then made a mere conclusory statement that the specification does not “reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” Accordingly, the Office Action presents no finding of fact of “why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed” as required of the Examiner.

Moreover, Applicant respectfully reminds the Examiner that the standard for meeting the written description requirement is not one requiring a literal recitation of claim phrases in the specification. *See, e.g.*, MPEP § 2163.02. “It should be noted...that exact terms need not be used *in haec verba* to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112.” *See, e.g.*, MPEP § 1302.01; *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976).

In view of the standard for meeting the written description requirement set forth in the MPEP and the burden imposed upon the Examiner in establishing a rejection under § 112, first paragraph, Applicant respectfully submits that the recitations of Claim 22 are fully supported by

the specification. In this regard, FIG. 5 illustrates an apparatus according to one embodiment of the invention. The apparatus comprises a host processor 27 and a memory 28 that is shown to be in communication with the host processor 27. The host processor 27 is described in paragraphs 49 to 51 to perform various functions. It is well known to persons having skill in the art that processors, such as the host processor 27, execute computer-readable program instructions, which then cause the processor to perform functions specified by the program instructions. These computer-readable program instructions executed by the processor are known to be stored and/or buffered for the processor in a memory, such as the memory 28. Accordingly, the specification clearly supports a memory having computer-readable program instructions stored therein. Moreover, the specification further recites “[i]n view of the foregoing description it will be evident to a person skilled in the art that various modifications may be made within the scope of the invention.” *See*, page 12 of the originally filed specification. Accordingly, the specification explicitly contemplates modifications well known to persons having skill in the art. Therefore, given the disclosed functionality and the presence of a memory 28 and host processor 27 in combination with the fact that it is well known to persons having skill in the art that computer-readable program instructions configured for causing a processor to perform various functionalities may be stored in a memory in communication with a processor and may be substituted for functionality otherwise described to be performed by hardware elements, the specification clearly demonstrates that the inventor, at the time the application was filed, had possession of the invention claimed in Claim 22.

Moreover, with respect to the recitation of “computer program product,” Applicant respectfully submits that this construct is explicitly sanctioned by the MPEP and under *In re Beauregard* and support therefore implicitly follows from the foregoing discussion. For example, the MPEP provides that “[w]hen a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim.” MPEP § 2106.01 (I). Accordingly, the recitation of a “computer program product” in Claim 22 defines the statutory class of Claim 22 and derives support from the disclosure as described above.

For at least the foregoing reasons, Applicant respectfully submits that the rejection of

Claim 22 under § 112 is overcome.

The Rejection of Claim 22 under § 101 is Overcome

The Office Action asserts that Claim 22 is directed to non-statutory subject matter. In this regard, the Office Action provides “‘The computer program product comprising at least one computer-readable memory medium’ renders the claims non-statutory because in the specification, the applicant doesn’t definite the computer program product comprising at least one computer-readable memory medium as ‘suitable data storage media including digital and analog transmission medium.’ Since the digital and analog transmission medium is non-tangible medium such as carrier wave and transmission signal, the claimed invention is directed to non-statutory subject matter.”

As best as the Applicant can discern from this ambiguous statement, it appears the Office Action is asserting that the computer-readable memory may be interpreted as a carrier wave. First, Applicant respectfully submits that the specification does not define the computer-readable memory (e.g., the memory 28) as comprising or encompassing a non-tangible medium. Nevertheless, Applicant has amended Claim 22 to recite that the computer-readable memory is tangible. Accordingly, this amendment renders the Examiner’s argument moot. Moreover, Applicant respectfully submits that the preamble of Claim 22 is a form explicitly sanctioned by the MPEP under *In re Beauregard*. Applicant therefore respectfully submits that the rejection of Claim 22 under § 101 is overcome.

The Rejection of Claims 1, 3-4, 7-8, 11-18, and 20-26 under §103(a) is Overcome

In addition to the ensuing reasons, Applicants respectfully submit that the rejection of Claims 1, 3-4, 7-8, 11-18, and 20-26 under §103(a) is improper and is overcome. In this regard, Anttila is cited as a basis of each of the §103(a) rejections of Claims 1, 3-4, 7-8, 11-18, and 20-26. Anttila qualifies as prior art under § 102(e) and not § 102(b), as the present application claims priority to PCT application 2004/004206, filed on December 14, 2004, which claims priority to British patent application GB0329491.5, filed on December 19, 2003. Anttila was not published until October 7, 2004, which is subsequent to the priority date of December 19, 2003

for the present application. The present application and Anttila are presently commonly assigned to Nokia Corporation and at the time the claimed invention subject of the present application was made, the invention subject of the present application was under an obligation of assignment to Nokia Corporation. Accordingly, the subject matter of Anttila and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” *See*, 35 U.S.C. §103(c) and MPEP § 706.02(l)(1)I. Therefore, Anttila cannot be properly used as a basis of any § 103(a) rejection of any of the pending claims in the present application.

The Rejection of Independent Claims 1, 18, 20, and 22 under §103(a) is Overcome

The Examiner finds that independent Claims 1, 18, 20, and 22 (“the independent claims”) are obvious in view of the combination of Mankovitz, Anttila, and Okamoto. A method according to Claim 18 includes receiving a search criterion. The search criterion comprises a partial or complete name of a radio station. The method further comprises generating a radio station name set, including at least one radio station name, by matching the search criterion with at least one piece of supplementary information broadcast in conjunction with a plurality of radio stations. Each piece of supplementary information comprises an associated radio station name. The method additionally comprises controlling a display to display the radio station name set, including at least one radio station name, generated by matching the search criterion with the supplementary information. The method also includes receiving a user selection of a radio station name, the user selection being from the radio station name set displayed on the display and generated by matching the search criterion with the supplementary information. Claims 1, 20, and 22 are directed to an apparatus, apparatus, and computer program product, respectively, and include substantially similar recitations.

As set forth above, Anttila cannot be used as the basis of a § 103 rejection. Applicant further respectfully submits that none of the other cited references, taken alone or in combination, teach or suggest each of the features of the independent claims.

Briefly, Mankovitz discloses a radio receiver that receives a “musical selection” and a “digital message signal”. The digital message signal is “a text message which includes the name

of the musical selection, the name of the artist performing the selection, and the name of the album in which the selection is located” (column 1, lines 50 to 54). The receiver apparatus includes a “user operated storage feature” which is “provided for storing the displayed text message, and for recalling it for displaying it at a later time” (column 1, lines 63-65). An object of Mankovitz is to “provide apparatus and methods for enabling a listener to rapidly and accurately identify broadcast musical selections” (column 1, lines 34 to 37). Another object of Mankovitz is “to provide apparatus and methods of storing selected musical selection identification information, and for recalling such information at a later time, to facilitate the purchase of the album containing that selection” (column 1, lines 38 to 42).

Okamoto, briefly, is directed to a DAB (Digital Audio Broadcast) radio receiver equipped with GPS 221, a controller 19 and a touch screen display device 30 (see column 6, lines 9 to 54).

The display device 30 is arranged to display the radio receiver’s current position “by utilising the GPS 221” (column 9, line 45). A controller of the receiver is arranged to extract, from broadcast radio waves, “broadcast-related information such as transmission site information, the broadcast station name (ensemble label) that was received, as well as the broadcast name (program label) of the regional program, from the DAB broadcast radio wave” (column 9, lines 46 to 50). The controller 19 “designates display positions on the display screen [of the display device] for broadcast-related information such as marks to show the transmission site position, the extracted broadcast station name and the program name of the regional program; and supplies information for the position display, marks showing the transmission site positions, broadcast station names and program names to the display device” (column 9, lines 54 to 62). The display device 30 “displays marks showing the transmission site position, the broadcast station name matching the broadcast radio wave sent from that transmission site and the program name of the regional programme, on [a] map displayed on the LCD 31 [of the display device 30]” (column 9, lines 66 to column 10 line 3).

Figure 5 illustrates an example of the display device of Okamoto. Column 10, lines 35 to 40 indicate that broadcast station names “and tuning information such as for tuning in broadcast radio waves corresponding to that broadcast station name, are matched and stored in the RAM 193 of the controller 19”. Column 11, lines 18 to 26 refers to figure 5 and states that “when the

user touches a finger on the display position for broadcast station name AL2, the coordinates for that position are returned to the controller 19. The controller 19, based upon the coordinate information... detects the tuning information matching the broadcast station name or program name for the display position (coordinate information)... or detects the tuning information and selection in the RAM 193 of the controller 19”.

Applicant respectfully submits that Mankovitz, however, does not teach or suggest receipt of supplementary information which comprises radio station names, or searching through radio station names. Mankovitz therefore fails to teach or suggest the following features of the independent claims, and indeed is not relied upon as such:

- receiving a search criterion, the search criterion comprising a partial or complete name of a radio station
- generating a radio station name set, including at least one radio station name, by matching the search criterion with at least one piece supplementary information broadcast in conjunction with a plurality of radio stations, wherein each piece of supplementary information comprises an associated radio station name
- controlling a display to display the radio station name set, including at least one radio station name, generated by matching the search criterion with the supplementary information
- receiving a user selection of a radio station name, the user selection being from the radio station name set displayed on the display and generated by matching the search criterion with the supplementary information

In addition, Applicant respectfully submits that Mankovitz does not teach or suggest the following additional feature of Claim 1:

- means for decoding... at least one piece of supplementary information comprising an associated radio station name

The Office Action posits that Okamoto teaches “means for receiving a search criterion, the search criterion comprising a partial or complete name of a radio station” as recited in claim 1 and similarly recited in the remaining independent claims of the present application. Although it is unclear to the Applicant, the Office Action appears to be equating “receiving a search

criterion” in the independent claims of the present application with a user touching a finger on the display device 30 in Okamoto, in order to control the radio receiver to receive radio waves from the radio station illustrated at that position on the display device 30.

The independent claims further recite generating a radio station name set, including at least one radio station name, by matching the search criterion with the supplementary information. The search criterion is defined as comprising “a partial or complete name of a radio station” and at least one piece of the supplementary information comprises “an associated radio station name”. Assuming *in arguendo* that a selection of a particular radio station displayed on the display device 30 of Okamoto is a “search criterion” in the language of the independent claims, Okamoto cannot be considered to teach or suggest the generation of a radio station name set “by matching the search criterion with the supplementary information”. This is because, in Okamoto, no radio station name set is generated after the user has touched the display device 30, “by matching the search criterion with supplementary information that comprises “an associated radio station name”.

Furthermore, Okamoto does not teach or suggest that the radio receiver displays anything that can be considered to be a “radio station name set” after the user has selected a particular radio station by touching the display device 30, nor are there any further opportunities for a user to select “a radio station name”. Okamoto does not therefore disclose “controlling a display to display the radio station name set... generated by matching the search criterion with the supplementary information” or “receiving a user selection of a radio station name, the user selection being from the radio station name set displayed on the display and generated by matching the search criterion with the supplementary information”, as recited by the independent claims.

Accordingly, neither Mankovitz nor Okamoto, taken alone or in combination teach or suggest receiving supplementary information in the form of radio station names, generating a radio station name set from the radio station names that matches a search criterion comprising a partial or complete name of a radio station, and controlling a display to display that radio station name set and enabling the user to select a radio station name from the displayed radio station name set. For at least the foregoing reasons, Applicant respectfully submits that none of the

cited references, taken alone or in combination, teaches or suggests the independent claims. Therefore, Applicants submit that the rejection of the independent claims is overcome and the independent claims are in condition for allowance.

The Rejection of the Dependent Claims is Overcome

Because the dependent claims include all of the recitations of a respective independent base claim, Applicants submit that the dependent claims are patentably distinct from the cited references, taken alone or in combination, for at least those reasons discussed above with respect to the independent claims and are in condition for allowance.

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CONCLUSION

In view of the amended claims and remarks presented above, it is respectfully submitted that all of the present claims of the present application are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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